

Tiffany & Company
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D. Amendment to drawing figures

No amendments to the drawing Figures are proposed.

E. Remarks

Reconsideration and allowance in view of the amendments made and comments which follow are respectfully requested.

Claims 1-23 were pending. No claims are being amended. Claims 1-23 are still now pending.

In the Office Action the Examiner rejected claims 1-3, 9, 11, 15 and 21 as allegedly anticipated by French Patent No. 324,092. The Examiner also rejected claims 4-8, 10-14, 16-19 and 23 as being allegedly obvious over the French Patent combined with Johnson U.S. Patent No. 5,072,549, and claims 20 and 23 as allegedly obvious over the French Patent, Johnson and U.S. Patent No. D369,758 to Remidio.

As described in the patent specification, there are three basic cutting styles, which are (1) step-cut, (2) brilliant cut, and (3) hybrid or mixed cut, which is a combination of the step and brilliant cuts. (See specification of subject U.S. Patent No. 6,363,745, col. 1, lines 36-49).

Applicant uses the term "mixed-cut" as described in the specification, and in the conventional manner to refer to a cutting style having both step-cut and brilliant-cut facets. The term is used to refer to a stone which does not have exclusively step cuts, or which does not have exclusively brilliant cuts, and is usually used to refer to a stone having (1) all step-cut facets in the pavilion and all brilliant-cut facets in the crown, or (2) all step-cut facets in the crown and all brilliant-cut facets in the pavilion. The French Patent No. 324,092 relates to an step-cut stone having only steps throughout its crown and pavilion. Because this French Patent has only step cuts, and no brilliant cuts, it is considered by those in the art as a step-cut design, and not a brilliant cut or hybrid (or mixed) cut.

All of the claims 1-3, 9, 11, 15 and 21, which have been rejected as allegedly anticipated by the French Patent, recite in the preamble that the cut is a "mixed-cut". Accordingly these claims are not anticipated by the French Patent.

In paragraph 7 of the Office Action, the Examiner stated that he disagreed with the definition of a mixed cut being defined as (1) a stone having all step-cut facets in the pavilion and all brilliant cut facets in the crown, or (2) all step-cut facets in the crown and all brilliant-cut facets in the pavilion. The Examiner stated that, because the French patent disclosed a crown according to claim 1, and a pavilion according to claim 1, one must assume that the stone is a mixed-cut gemstone. As understood by applicant, the Examiner is defining a term in the preamble (the term "mixed cut") by looking solely to the structural recitations after the word "comprising" in claim 1. As understood by applicant, the Examiner stated that if a structure has the features in the portion of a claim after the word "comprising" (i.e., the portion of the claim after the preamble), one can define a term in the preamble with reference to such structure.

Applicant respectfully disagrees, in view of applicant's understanding of how the Court of Appeals for the Federal Circuit interprets claim language in a preamble.

In Corning Glass Works v. Sumitomo Elec. USA., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), the court held that the determination of whether a preamble recitation is a structural limitation can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."

In Corning Glass, the claim at issue was as follows:

An optical waveguide comprising

- (a) a cladding layer formed of a material selected from the group consisting of pure fused silica and fused silica to which a dopant material on at least an elemental basis has been added, and
- (b) a core formed of fused silica to which a dopant material on at least an elemental basis has been added to a degree in excess of that of the cladding layer so that the index of refraction thereof is of a value greater than the index of refraction of said cladding layer, said core being formed of at least 85 percent by weight of fused silica and an effective amount up to 15 percent by weight of said dopant material.

A defendant in an infringement action asserted that the claim was anticipated by a prior art reference disclosing an identical structure having the features of parts (a) and (b) of the claim, but which was not being used as an “optical waveguide”, the language in the preamble.

The Federal Circuit Court stated:

To say that a preamble is a limitation if it gives “meaning to the claim” may merely state the problem rather than lead one to the answer. The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim. Here, the 915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only.

The specification of the patent at issue contained substantial disclosures of the manner of creating optical waveguides using the material described in the part (a) “core” and part (b) “cladding” parts of the claim. In order to function in the manner intended in the specification the term “optical waveguide” was construed as essential to the invention, and served to distinguish over the prior art..

Similarly, in the present case, the preamble term “mixed cut” as understood from the specification refers to the type of gemstone to which the invention is directed, and each of the objects in the Summary section include mixed cut as an attribute of the invention. The term “mixed cut” refers to a stone which is not exclusively a step cut or brilliant cut, but which is a mixture of the two different types of cuts, and more particularly to a stone which has step cuts in one of its crown or pavilion, and brilliant cuts in the other of its crown or pavilion.

The term “mixed cut” is a structural term, and should be given meaning to distinguish over the prior art. The MPEP §2111.02 also clearly states that structural terms (like mixed cut) must be considered to construe the claim. For the foregoing reasons, applicant urges that claims 1-3, 9, 11, 15 and 21 should be construed to distinguish patentably over the exclusive step cut design of the French patent, and respectfully requests withdrawal of the anticipation rejection.

Claims 4-8, 10-14, 16-19 and 23 have been rejected as allegedly obvious over the French Patent in view of U.S. Patent No. 5,072,549 to Johnson. The Examiner alleged that the claimed features not disclosed by the French Patent were disclosed by Johnson, and that “It would have been an obvious design choice to a person having ordinary skill in the art to modify the French Patent’s pavilion faucets to include [the claimed feature] in order to change the aesthetic appearance of the gemstone to improve its marketability and value to prospective customers.”

Applicant respectfully disagrees, and respectfully traverses this rejection. In addition to the reasons stated above that the French patent is not a mixed, applicant urges that it would not have been obvious to modify the French patent and combine it with the Johnson patent because their designs are considered by those skilled in the art as vastly different in structure and purpose. The French patent relates to a simple step cut design in both the crown and pavilion, and is viewed in the art as being exclusively a step cut stone. The Johnson patent is a brilliant cut design in both the crown and pavilion, and is viewed in the art as being exclusively a brilliant cut stone. Applicant urges that one of ordinary skill in the art would not be motivated to modify the exclusively step cut design of the French patent by taking away its entire step cut pavilion and replacing it with the entire brilliant cut pavilion of the Johnson patent. The French patent step cut design and the Johnson patent brilliant cut design have different design objectives and each has acquired a different status in the art. Moreover, the French patent relates to a cut-cornered stone having four sides and four corners in the crown and pavilion, whereas the Johnson patent relates to a five sided or pentagonal stone in the crown and pavilion. In view of these differences, applicant urges that one skilled in the art would not be motivated to combine these references.

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With respect to the rejection of claims 20 and 23, which have been rejected as allegedly obvious over the French patent combined with Johnson and U.S. Patent No. D 369,758 to Remidio, applicant refers to the same arguments above regarding the non obviousness of combining the French patent with the Johnson patent.

The Remidio Patent does not overcome the deficiencies of the French patent with the Johnson patent, with respect to the propriety of combining an all step-cut cut-cornered stone (of four sides and four corners) with a five sided all brilliant cut stone.

In view of the foregoing, applicant believes that the application is in condition for allowance, and such action is earnestly solicited.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No additional fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

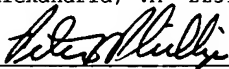
Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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